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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,675	11/27/2001	Masao Okubo	216132US2	8021

28970 7590 03/06/2006

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EXAMINER

NGUYEN, TRUNG Q

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,675

Applicant(s)

OKUBO ET AL.

Examiner

Trung Q. Nguyen

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on election filed on 01/09/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant has traversed the requirement to elect with the indication that the subject matter of all claims 18-33 are sufficiently related what a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of the non-elected claims. It is noted also that applicant has failed to show why and how there would be related in the subject matter of elected and non-elected claims. For example, applicant could have stated that: (1) No consideration would be necessary for any of the embodiments beyond one embodiment; or (2) None of the embodiments are patentable over any of the other embodiments. Whatever applicant's reason for there being related subject matter in examining all embodiments, it is the examiner's position that each embodiment is patentable over the other and requires separate consideration and search. In making the search, links of reasons must be followed for each of the embodiments. This restriction is now final, claims 18-27 are pending and claims 28-33 are withdrawn as being non-elected claims.

Admission on the record that none of the embodiments are patentable over any other the embodiments will result in rejoining and examination of all species (embodiments).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al. (U.S. 5,974,662).

Regarding claims 18-19 and 21-22 Eldridge et al. disclose in Figures 1-2 and in Column 12, lines 37-65 a probe card has a structure where nickel alloy is applied to the surface of a core material made of palladium alloy or beryllium copper alloy (column 12, lines 47-55).

Note: in claims 18 and 20, limitations “a wire drawing operation with a wire-drawing die is performed, wherein the probe sustains a substantially higher contact force as compared to a probe made of metal alloy wire that is not subject to the wire drawing operation” are considering as a “product by process”, therefore, the above limitations will not have any patentable weight. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 4, Eldridge et al. disclose in column 12, lines 37-45 the non-oxidizable film herein terms are gold, platinum, rhodium, palladium, iridium, etc., and these metals are elements which are thermally diffused into tungsten via upper-most surface of probe. Wherein a wire drawing operation is performed (column 12, lines 37-65).

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Regarding claim 20, base on the above note, claim 20 will not have any patentable weight.

Claims 23-27 add the limitation wherein the probe diameter is 65 micrometer, nickel alloy plating is 3-15 micrometer, old plating is about 0.2-1.0 micrometer etc. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the probe diameter, thickness of nickel or gold plating dimension to receive the above measurements because it has been held that changes in shape and size are a matter of obvious design choice, absent any persuasive evidence that the change in configuration was significant.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Nguyen whose telephone number is **(571) 272-1966**. The examiner can normally be reached on Monday through Friday, 8:30AM – 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cuneo Kamand can be reached at **(571) 272-1957**.

Trung Nguyen
Patent Examiner
Group Art Unit 2829
March 01, 2006

Jel ~ Hta
JERMELE HOLLINGTON
PRIMARY EXAMINER
AV 2829
03/02/06